

REMARKS

Replacement sheets of formal drawings will be furnished so that the formal drawings conform to the informal drawings originally filed. The inconvenience to the office is sincerely regretted. Claims 14-20 have been amended without being narrowed to overcome a minor informality. Such amendments to claims are only for the purpose of expediting the prosecution of this application and are not to be construed as an abandonment of any of the novel concepts disclosed therein.

The objection to the disclosure on page 5, line 27 is noted but respectfully traversed. The word "the" is proper there.

The office action states:

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz (5845441) in view of Lockwood (6854928). Swartz claims a pre-manufactured portable concrete structure comprising a floor, wall, and ceiling member detachable from one another (Swartz, Claims 1 and 11). It does not however disclose the use of a compliant, or protective, pad.

Lockwood discloses a rubber pad (44) between support structures (Column 2, line 41). It would be obvious to a person of ordinary skill in the art to have a protective (rubber) pad between adjacent concrete members, like that disclosed in Lockwood, to protect the members from damage during movement.

It is further noted, for Claim 2, that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice (In re Leshin, 125 USPQ 416). It is well known within the art that synthetic rubber significantly absorbs shock from movement and thus placing it between concrete members to prevent damage would be obvious.

In response to applicant's claim that the structure of Claim 1 can serve as a school classroom, an apartment unit, or an office space (Claims 11-13), a recitation of intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The invention claimed in Swartz could be exercised for any of the intended uses claimed by the applicant in Claims 11-13.

Regarding claim 3, and the limitation of "a channeled layer attached to the floor and ceiling members," this same structure, defined as "interconnecting conduits," is disclosed in column 8, lines 19-24 of Swartz. Swartz also continues, Figures 10 and 11 (represented below) show "common means that typifies the inclusion of electrical, water, and sewage lines within and throughout the structure of the concrete house." The "common means" encompasses all conduits, openings, or channels for utilities to run through.

Regarding claim 4, the structure of Swartz combined with Lockwood as described above is considered a "composite system."

Regarding claim 5, the structure of Swartz combined with Lockwood as described above is considered "adapted to detachably engage" a second building module. It is well known in the art that one of ordinary skill could bolt two building modules to one another.

Regarding claim 9, the structure of Swartz combined with Lockwood as described above is considered "adapted for attachment to a preexisting structure." It is well known in the art that one of ordinary skill could bolt the building module to a preexisting structure.

Regarding claim 8, Swartz discloses in column 8, lines 21-30, "...interconnecting conduits (134) join at connecting walls, floor/foundation (22) or ceiling roof sections..." This reads directly on a "conduit extending through the members" claimed in claim 8 of the application. The claimed "conduit" of claim 8 would also be considered obvious to one of ordinary skill in the art as stated in Swartz (column 8, lines 14-16), "common means that typifies the inclusion of electrical, water, and sewage lines within and throughout the structure of the concrete house."

Regarding claim 10, Swartz reveals in the drawings (91) and disclosure a "final paint coat system." This classifies, to a person of ordinary skill in the art, as an "exterior facade surface." P.p. 4-9

This ground of rejection is respectfully traversed.

As the Supreme Court said in *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q. 2d 1385, 1397 (U.S. 2007)

A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. See *Graham*, 383 U.S., at 36 (warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to “guard against slipping into the use of hindsight” (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F. 2d 406, 412 [141 USPQ 549] (CA6 1964))).

Moreover, the primary reference discloses the tight coupling among panels in the verbal description and every figure in the drawings. FIG. 8 is reproduced on the cover page and plainly shows the solid connections between adjacent panels. Placing compliant material between adjacent panels would destroy the function of the primary reference tight coupling between adjacent panels.

In *Ex parte Sternau*, 155 U.S.P.Q. 733, 735 (Bd. of Appeals 1967) the Board said:

However, there is nothing in the disclosures of [primary reference] Young and [secondary reference] Haslacher that would teach the Examiner's proposed combination or any reason for making it. In fact, the proposed combination would destroy the Young apparatus for its intended purpose. Thus, we will reverse the rejection of claims 44 and 45 for this reason.

With regard to the contention regarding a matter of obvious design choice, that is a conclusion, not a reason in support of rejection. In *In re Garrett*, 33 PTCJ 43 (BPA&I, September 30, 1986) the Board criticized the Examiner's statement that the proposed modification would have been "an obvious matter of engineering design choice" as a conclusion, not a reason, in reversing the section 103 rejection.

In any event claim 2 is dependent upon and includes all the limitations of claim 1 so that the reasoning in support of the patentability of claim 1 is submitted to support the patentability of claim 2.

Since claims 2-13 are dependent upon and include all the limitations of claim 1, the reasoning set forth above in support of the patentability of claim 1 is submitted to support the patentability of claims 2-13.

The office action adds a tertiary reference in rejecting claims 6 and 7 stating:

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz (5845441) and Lockwood (6854928) in view of Fisher (4050213). It is well known in the art of building construction that removing a roof to add a second level is commonplace, thus it would be obvious to one of ordinary skill in the art to use the illustrations of Fisher (below) in conjunction with the disclosures of Swartz and Lockwood (described above) to arrive at the claimed material in claims 6 and 7. P.p. 6.

Since claims 6 and 7 are dependent upon and include all the limitations of claim 1, the reasoning set forth above in support of the patentability of claim 1 is submitted to support the patentability of claims 6 and 7 so that further discussion of the tertiary reference is submitted to be unnecessary.

The office action states:

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Menke (5265384) in view of Swartz (5845441) and Hoffman (6094873). Menke claims a "prefabricated living quarters structure to be received within an existing building." Menke, however, does not teach a pre-fabricated concrete structure.

Swartz claims a pre-manufactured portable concrete structure comprising a floor, wall, and ceiling member detachable from one another (Claims I and 11), reinforced with rebar (Figure 8, label 120), and a channeled layer or conduit. It would be obvious to one of ordinary skill in the art to combine pre-fabricated living quarters of Menke with the portable concrete structure of Swartz because concrete structures are stronger and are produced in bulk more easily. Swartz does not teach a connecting layer composed of neoprene pads. It is, however, well known in the art to use neoprene pads to reduce damage from earthquakes or sudden movements (Hoffman, Claim 7). It would be obvious to one of ordinary skill in the art to use neoprene pads in the connecting layer if the connecting layer were to be used in conjunction with moving the structure.

It is further noted, for Claim 15, that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for

the intended use as a matter of obvious design choice (In re Leshin, 125 USPQ 416). It is well known within the art that synthetic rubber significantly absorbs shock from movement and thus placing it between concrete members to prevent damage would be obvious.

Regarding claim 16, and the limitation of "a channeled layer attached to the floor and ceiling members," this same structure, defined as "interconnecting conduits," is disclosed in column 8, lines 19-24 of Swartz. Swartz also continues, Figures 10 and 11 (represented above) show "common means that typifies the inclusion of electrical, water, and sewage lines within and throughout the structure of the concrete house." The "common means" encompasses all conduits, openings, or Channels for utilities to run through.

Regarding claim 17, the structure as described above is considered "adapted to detachably engage" a second building module. It is well known in the art that one of ordinary skill could bolt two building modules to one another.

Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Menke (5265384) in view of Swartz (5845441) and Fisher (4050213). It is well known in the art of building construction that removing a roof to add a second level is commonplace, thus it would be obvious to one of ordinary skill in the art to use the illustrations of Fisher (above) in conjunction with the disclosures of Menke and Swartz (described above) to arrive at the claimed material in claims 18 and 19.

Regarding claim 20, Swartz discloses in column 8, lines 21-30, "...interconnecting conduits (134) join at connecting walls, floor/foundation (22) or ceiling roof sections..." This reads directly on a "conduit extending through the members" claimed in claim 20 of the application. The claimed "conduit" of claim 20 would also be considered obvious to one of ordinary skill in the art as stated in Swartz (column 8, lines 14-16), "common means that typifies the inclusion of electrical, water, and sewage lines within and throughout the structure of the concrete house." P.p. 9-11.

Like the secondary reference, the primary reference also discloses adjacent panels tightly interconnected. Thus, combining the references as proposed by the Examiner would destroy the functions of the primary and secondary references in having the adjacent panels tightly interconnected.

Accordingly, withdrawal of the rejection of claims 14-20 as unpatentable over the primary, secondary and tertiary references is respectfully requested.

The courtesy of the Examiner in conducting a diligent search is acknowledged with appreciation. The references cited, but not applied, have been examined and are submitted to be incapable of anticipating, suggesting or making obvious the subject matter as a whole of the invention disclosed and claimed in this application.

In view of the foregoing amendments, authorities, remarks and the inability of the prior art, alone or in combination, to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. Should the Examiner believe the application is not in a condition for allowance, he is respectfully requested to telephone the undersigned attorney at 617-521-7014 to discuss what addition steps he believes are necessary to place the application in a condition for allowance.

Please apply any charges or credits to deposit account 06-1050, Order No. 16027-002001.

Respectfully submitted,
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Date: _____

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